

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael L. Denby

) Ex: WALSH

Serial No.: 10/010361

) Art Unit: 3676

Filed: 13 November 2001

Title: QUICK RELEASE ASSEMBLY

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TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

Enclosed is the Brief on Appeal and two copies of the same, in compliance with the Rules, in the above captioned matter, and a check in the amount of \$160.00, the requisite fee set forth in 37 CFR 1.17(c).

Respectfully submitted,

Michael W. Goltz
Attorney for Applicant
Registration No. 39,692

12 September 2003

340 East Palm Lane
Suite 260
Phoenix, Arizona 85004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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9/25/03

Applicant: Michael L. Denby) Ex: WALSH
Serial No.: 10/010361)
Filed: 13 November 2001) Art Unit: 3676
Title: QUICK RELEASE ASSEMBLY)

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NOTICE OF APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

Applicant hereby appeals to the Patent Office Board of Appeals from the decision dated 07 Jul7 2003 of the Examiner finally rejecting claims 20 - 38 of the instant application. A shortened statutory period for response was set for three (3) months, up to and including 07 October 2003. The item(s) checked below are appropriate:

1. ☒ Appeal fee (37 CFR 1.17(e))
[] other than small entity fee \$320.00
☒ small entity fee \$160.00

09/16/2003 MGBREM1 00000123 10010361

01 FC:2401

160.00 OP



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael L. Denby

) Ex: WALSH

Serial No.: 10/010361

) Art Unit: 3676

Filed: 13 November 2001

Title: QUICK RELEASE ASSEMBLY

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CERTIFICATE OF MAILING

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

I hereby certify that the attached Notice of Appeal; Transmittal Letter; Appeal Brief and two (2) copies; Checks for appropriate fees; and a postcard are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, Mail Stop Appeal Brief-Patents, on 12 September 2003.

Walter G. Schuster
Signature

12 September 2003

12 September 2003
Date

Respectfully submitted,

Michael W. Goltry
Michael W. Goltry
Attorney for Applicant
Reg. No. 39,692

Parsons & Goltry
340 East Palm Lane
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Phoenix, Arizona 85004
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2. ☐ A petition and fee for an extension of time for reply to the rejection is attached.

Extension fee (37 CFR 1.17 (a) - (d))

☐ other than small entity

☐ \$110 ☐ \$400 ☐ \$920 ☐ \$1,440

☐ small entity

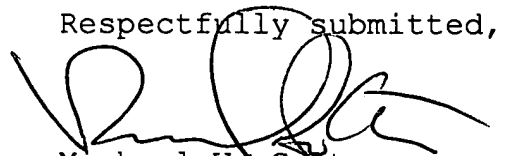
☐ \$55 ☐ \$200 ☐ \$460 ☐ \$720

3. ☒ Check in the amount of \$160.00 is attached.

Please direct all correspondence to:

Michael W. Goltry
340 East Palm Lane, Suite 260
Phoenix, Arizona 85004
(602) 252-7494

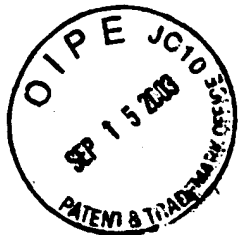
Respectfully submitted,



Michael W. Goltry
Attorney for Applicant
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12 September 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Michael L. Denby

Serial No.:
10/010,361

Filed:
November 13, 2001

For:
QUICK RELEASE ASSEMBLY

Ex: Walsh, John B.
Art Unit: 3676

#12
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BRIEF FOR APPELLANT

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Please consider the contents of the following Brief for Appellant.

09/16/2003 MGE BREM1 00000123 10010361

02 FC:2402

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I. REAL PARTY IN INTEREST

Appellant Michael L. Denby is the real party in interest to the above-described patent application.

II. RELATED APPEALS AND INTERFERENCES

No appeals or interferences relate to the above-described patent application.

III. STATUS OF THE CLAIMS

1. Claims 1, 4-9, and 12-38 are pending.
2. Claims 1, 4-9, and 12-19 are allowed and not part of this Appeal.
3. Claims 20-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Denby et al. (U.S. Patent 5,878,662) in view of Brown (U.S. Patent 2,720,804).
4. A copy of claims 20-38, the claims on appeal, is provided in Appendix A.

IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

No amendments were filed subsequent to the final rejection of July 7, 2003 (paper no. 10).

V. EXPLANATION OF THE INVENTION

The application on appeal discloses and claims apparatus including a handle having a key, a piston having a bore, and a cam having first and second ends held by a cap for rotation in the bore. One of the first and second ends has a keyway capable of receiving the key. In one embodiment, there is a magnetic attraction between the cam and the key. In another embodiment, there is a magnetic engagement between the cam and the key. In yet another embodiment, the piston is attached to an axle mounted to a hub. In still another embodiment, the hub is attached to a bicycle wheel.

VI. ISSUE FOR REVIEW

Whether the invention claimed in claims 20-38 is obvious under 35 U.S.C. 103(a) as being unpatentable over Denby et al. (U.S. Patent 5,878,662) in view of Brown (U.S. Patent 2,720,804).

VII. GROUPING OF CLAIMS

Independent claim 20 and dependent claims 21-25 are drawn to apparatus. Independent claim 26 and dependent claims 27-31 are drawn to apparatus. Independent claim 32 and dependent claims 33-35 are drawn to apparatus. Independent claim 36 and dependent claims 37 and 38 are drawn to apparatus.

VIII. ARGUMENT

Claims 20-38 are not obvious under 35 U.S.C. 103(a) as being unpatentable over Denby (U.S. Patent 5,878,662) in view of Brown (U.S. Patent 2,720,804).

Claims 20-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Denby et al. (US. Patent 5,878,662) in view of Brown (U.S. Patent 2,720,804). Appellant respectfully traverses Examiner's rejections of claims 20-38

In paper no. 10, Examiner asserts that Denby et al. teach a handle (52) having a key (54); a piston (64) having a bore (88); a cam (74) having a keyway (78), in which the cam (74) is held by a cap (66). As to claims applicant's claims 21, 27, 33, and 37, examiner asserts that the keyway (78) is disposed off center of the cam. As to applicant's claims 22 and 28, Examiner asserts that the piston (64) is attached to a removable part of a bicycle. As to applicant's claims 23 and 29, Examiner asserts that the piston (64) is attached to a hub (14). As to applicant's claims 24, 30, and 34, Examiner asserts that the hub (14) is attached to a wheel. As to applicant's claims 25, 31, 35, and 38, Examiner asserts that the hub (14) is attached to a bicycle frame. As to applicant's claims 32 and 36, Examiner asserts that Denby et al. teach a handle (52) having a key (54); a piston (64) attached to an axle (57) mounted to a hub (14) attached to a bicycle wheel, the piston (64) having a bore (88); a cam (74) having a keyway (78), in which the cam (74) is held by a cap (66). Examiner admits that Denby et al. fails to teach a magnetic attraction/engagement between the cam and the key. However, Examiner cites Brown for teaching a magnetic attraction/engagement between a recess on

one element and a key/tool. Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the key and cam of Denby et al. with a magnetic attraction/engagement between the two elements, as taught by Brown, in order to better retain the two elements together. Applicant respectfully traverses Examiner's section 103 rejections of claims 20-38 and the reasons set thereof as set forth by Examiner in paper no. 10.

In accordance with standard Patent Office practice, the Examiner has the burden of establishing a prima facie case of obviousness. (Manual of Patent Examining Procedure, M.P.E.P. 2142). Three basic criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or the references when combined) must teach or suggest all the claim limitations. According to the U.S. Court of Appeals for the Federal Circuit, "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. . . . Rather, we look to see whether combined *teachings* render the claimed subject matter obvious."¹ Also, "[o]bviousness cannot be established by combining the teachings of the prior art to produced the claimed invention, absent some teaching suggestion or incentive supporting the combination."²

An invention does not make itself obvious; that suggestion or teaching must come from the prior art. Examiner's conclusion that that it would have been obvious to provide a key and cam of Denby et al. with a magnetic attraction/engagement between the two elements as taught by Brown in order to better retain the two elements in engagement does not come from Denby et al. or from Brown. There is no teaching or suggestion in Denby et al. of the desirability of incorporating magnetic attraction/engagement between its key and cam. There is no teaching or suggestion in Brown of the desirability of incorporating a magnetic attraction/engagement between a key and cam of an assembly consisting of a

¹*In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 U.S.P.Q. 545, 549-50 (C.C.P.A. 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (C.C.P.A. 1964)).

handle having the key, a piston having a bore, and the cam disposed in the bore and having a keyway, as claimed by applicant. Accordingly, it is not proper to combine the teachings of Denby et al. with those of Brown. At most, Brown teaches magnetic engagement between two elements. However, just because magnetic engagement is known does not make it obvious in every application, and certainly does not make it obvious in connection with applicant's claimed invention without some teaching or motivation in the art explaining the desirability of providing a magnetic attraction/engagement between applicant's claimed key and cam.

There is no teaching in Denby et al. and/or Brown of the desirability to combine Brown with Denby et al. Accordingly, the combination of Denby et al. and Brown is improper. If there is a teaching or suggestion to combine the teachings of Denby et al. with Brown, it comes from applicant's patent application and not from the prior art, namely, Denby et al. and/or Brown. Furthermore, even assuming *arguendo* that even the combination of Denby et al. and Brown is proper, there is no teaching in either reference of where to incorporate a magnetic attraction. That teaching comes only from applicant's specification.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."³ Although the Examiner has identified, in the prior art, a quick release assembly in Denby et al. and magnetic attraction/engagement in Brown, the Examiner has not identified a teaching or suggestion in the prior art to combine these elements as claimed and set forth by applicant in independent claims 20, 26, 32, and 36. Furthermore, although Examiner states (hereinafter referred to as "Examiner's statement") that it would have been obvious to provide a key and cam of Denby et al. with a magnetic attraction/engagement between the two elements as taught by Brown in order to better retain the two elements in engagement, Examiner has failed to identify such a teaching or suggestion in the prior art, namely, Denby et al. and/or Brown, and appears to be working from personal knowledge in

² See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).

³ *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 43 USPQ 2d 1294 (Fed. Cir. 1997).

making this statement. Although in Applicant's April 22, 2003, response Applicant respectfully traversed Examiner's obviousness conclusion and also requested an affidavit from the Examiner in connection with Examiner's statement, Examiner failed to provide Applicant with the requested affidavit.

Accordingly, Appellant asserts that the Examiner erred rejecting claims 20-38 as obvious under 35 U.S.C. 103(a) as unpatentable over Denby et al. in view of Brown, that the combination of Denby et al. and Brown is an improper combination, and that claims 20-38 are not obvious under section 103 as being unpatentable over Denby et al. in view of Brown.

IX. Conclusion

Appellant asserts that following claims on appeal are not obvious and not unpatentable and should be allowed:

1. Independent claim 20 and dependent claims 21-25,
2. Independent claim 26 and dependent claims 27-31;
3. Independent claim 32 and dependent claims 33-35; and
4. Independent claim 36 and dependent claims 37 and 38.

It is respectfully submitted that Appellants' claims 20-38 are clearly allowable and that this case is in condition for allowance. Appellant therefore prays for the reversal of the final rejection of claims 20-38 and the allowance of the subject application.

Respectfully submitted,

Michael L. Denby



Michael W. Goltry
Attorney for Appellant
Reg. No. 39,692

September 5, 2003
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APPENDIX A



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20. Apparatus comprising:

a handle having a key;

a piston having a bore;

a cam having first and second ends held by a cap for rotation in the bore, one of the first and second ends having a keyway capable of receiving the key; and

a magnetic attraction between the cam and the key.

21. Apparatus of claim 20, wherein the keyway is disposed off center of the cam.

22. Apparatus of claim 20, wherein the piston is attached to a removable part of a bicycle.

23. Apparatus of claim 20, wherein the piston is attached to a hub.

24. Apparatus of claim 23, wherein the hub is attached to a wheel.

25. Apparatus of claim 25, wherein the hub is attached to a bicycle frame.

26. Apparatus comprising:

a handle having a key;

a piston having a bore;

a cam having first and second ends held by a cap for rotation in the bore, one of the first and second ends having a keyway receiving the key; and

a magnetic engagement of the key to the cam.

27. Apparatus of claim 26, wherein the keyway is disposed off center of the cam.

28. Apparatus of claim 26, wherein the piston is attached to a removable part of a bicycle.

29. Apparatus of claim 26, wherein the piston is attached to a hub.

30. Apparatus of claim 29, wherein the hub is attached to a wheel.

31. Apparatus of claim 29, wherein the hub is attached to a bicycle frame.

32. Apparatus comprising:

- a handle having a key;
- a piston attached to an axle mounted to a hub, the piston having a bore;
- a cam having first and second ends held by a cap for rotation in the bore, one of the first and second ends having a keyway capable of receiving the key; and
- a magnetic attraction between the cam and the key.

33. Apparatus of claim 32, wherein the keyway is disposed off center of the cam.

34. Apparatus of claim 32, wherein the hub is attached to a wheel.

35. Apparatus of claim 32, wherein the hub is attached to a bicycle frame.

36. Apparatus comprising:

a handle having a key;

a piston attached to an axle mounted to a hub attached to a bicycle wheel, the piston having a bore;

a cam having first and second ends held by a cap for rotation in the bore, one of the first and second ends having a keyway capable of receiving the key; and

a magnetic attraction between the cam and the key.

37. Apparatus of claim 36, wherein the keyway is disposed off center of the cam.

38. Apparatus of claim 36, wherein the hub is attached to a bicycle frame.